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In re Application of :  
KYLER et al :  
U.S. Application No.: 10/553,825 :  
PCT No.: PCT/US04/12425 :  
Int. Filing Date: 21 April 2004 : DECISION  
Priority Date: 21 April 2003 :  
Attorney Docket No.: 20030081 :  
For: PROCESS FOR PREPARING HIGH :  
PURITY TNT :  
:

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 08 January 2007.

**BACKGROUND**

On 31 July 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 08 January 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by two of the three named inventors; a statement by Daniel J. Long; a three-month extension and fee; the petition fee of \$200.00; a copy of a letter dated 21 September 2006; a copy of an email dated 21 September 2006 and authorization to charge any additional fee to Deposit Account No. 19-0130.

**DISCUSSION**

Applicants claim that they have been unable to locate Keith Kyler and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 31 July 2006.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Applicants completed items (1) and (3) with this petition.

Concerning item (1), the petition fee is now \$200.00. Petitioners submitted a \$130.00 petition fee. The \$70.00 difference has been charged to Deposit Account No. 19-0130 as authorized.

With regards to item (3), the last known address of co-inventor Keith Kyler is listed as:

1401 University Blvd., Apt D-3  
Kingsport, TN 37660

However, regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants submitted a statement of facts by Mr. Long, an attorney representing the assignee. Mr. Long states that a letter sent to the last known address of the nonsigning inventor was returned as being undeliverable. Moreover, a co-inventor was contacted by email, but he did not know the whereabouts of Mr. Kyler. A copy of the email and a copy of the cover letter sent to the nonsigning inventor was included as evidence in the petition. Petitioners did not state that they made any other attempts to locate the nonsigning inventor and no other evidence was provided.

This evidence is insufficient to show that a "diligent effort" was made to locate the nonsigning inventor. Petitioners did not even attempt to locate Mr. Kyler using the internet or telephone. In addition, Mr. Kyler would likely belong to professional organizations. Moreover, a check with Human Resources and other co-workers should be done to see if anyone has any information on the whereabouts of Mr. Kyler.

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Documentary evidence of the attempts made to locate the nonsigning inventor should be included with any renewed petition. For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of all three inventors are recorded on the declaration as required. However, this declaration fails to comply with 37 CFR 1.497(a) and (b).

Petitioners submitted one first page and two second pages of the declaration. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Applicants must submit the complete declaration signed by each co-inventor.

For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

#### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
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